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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,963	11/28/2001	Azeem Ahmad	13793RRUS02U	9223

7590 01/20/2006
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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,963

Applicant(s)

AHMAD ET AL.

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-14 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,5-7 and 21-23 is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1-3-2006 have been fully considered but they are not persuasive.

1. The applicant argues that claim 8 is not properly rejected and that a prima facie case has not been established. The examiner disagrees since the claim is broadly written and thus, broadly interpreted. Note that the specification states (see page 4):

“..An access and controller are formed that voice call that enables the two systems to facilitate and respond to a to be terminated to a hybrid mobile station even though potentially specifically, a signal to the access network controller, referenced herein as a pseudo-page signal, to determine whether the hybrid mobile station is present and available. The pseudo-page signal is transmitted prior to the transmission of paging signals by the base station to establish the voice call. According to the response received from the access network controller, the base station either pages the hybrid mobile station to establish the voice call, forwards the call voice mail, forwards the call either to an Internet Call Delivery Server or to an Internet Call-Waiting Server for further processing..”

Claim 8 is so broadly written that it lacks considerable detail as to limit the way the examiner can interpret it. It is the examiner's position that the claim merely states a method to redirect a mobile that may be engaged in one type of call to another type (eg. from a data call to a voice call, similar to the applicant's specification). The claim does not state when, after being directed, that the mobile device receive pages. Therefore, the examiner's prior art only needs to show that the mobile has been redirected and then can receive pages in the other state.

As put forth in the previous rejection(s), Gilchrist teaches a mobile device that can connect to networks for voice calls and/or data calls. Signalling messages are used to redirect the mobile from one service to another (eg. from data to voice OR voice to data). There is no need for Gilchrist or Hays to state that paging must then occur, only that the user has been redirected and would therefore would be in a “new” state to receive paging messages in said new state (eg. having been changed from data to voice service). Therefore the examiner disagrees with the applicant's argument that the

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prior art does not teach redirecting a mobile to receive pages, it's just a matter of when the prior art will receive them (eg. in the future).

2. For claim 11, the examiner holds to his rejection for claim 8 and therefore holds to his rejection for claim 11 (there doesn't seem to be an argument, merely a request that this claim be allowed since the applicant feels that claim 8 is allowable).

3. The previously transmitted Office Action is attached as FYI.

4. **After further review, the examiner believes the following amendment would provide a more favorable outcome:**

> Claim 8 + claim 9 + claim 10 + (11 or 12 or 13 or 14) (eg. 4 claims total)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10, 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Gilchrist et al. US 5,745,695 and further in view of Hays WO95-26113 (hereafter Gilchrist and Hays).

As per **claim 8**, Gilchrist teaches a method in a communication network (title) comprising:

Receiving a signal/message transmitted by a BTS in a specified interface signal between BTS and access network controller (eg. SGSN) [figures 1-2 show a message/page sent from mobile/BTS/BSS to SGSN for suspending/resuming data flow. Also note that figures 1-2 show the SGSN communicating with the BSS and mobile which inherently requires communication circuitry]; and

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Generating from the access network controller, a response to a BTS to advise it that a HMS has been paged and is being redirected to receive pages from the voice network ~~a corresponding response~~ (figures 1-2 shows the SGSN responding with a message based on the message from the mobile/BTS, note direction of arrows on #21 and #29 in figures 1 and 2 respectively. Gilchrist teaches support for both voice and data operations to/from the mobile unit -- such as for a hybrid phone).

But is silent on a pseudo-paging signal.

While Gilchrist does teaches a message/signal (eg. page) being sent between mobile/BSS and SGSN (figures 1-2) the examiner puts forth **Hays** who teaches data transmission in a mixed mobile cellular/paging radio system (title) whereby the system can identify a mobile user as a hybrid phone/pager device and subsequently can send a data message via voice channel and/or pager channel which reads on determining whether the mobile is a hybrid station (abstract and Summary of Invention pages 2-4).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gilchrist, such that a pseudo-paging signal is used, to provide means for the network to transmit pages via both data/page and voice channels.

As per **claim 9**, Gilchrist in view of Hays teaches claim 8 wherein the response includes commanding a hybrid mobile to redirect and to suspend a data call so that it may receive and respond to paging signals transmitted by a BTS (figures 1-2 show the mobile/BTS informing the SGSN to suspend data transmission so that it may connect to the MSC/HLR/VLR, also see C4, L9-16 which teaches barring/forwarding voice calls, but one skilled would be able to perform this same service when engaged in a voice call, eg. bar/forward data calls).

As per **claim 10**, Gilchrist in view of Hays teaches claim 9 wherein the response includes waiting long enough to enable the hybrid mobile station to switch from the data network to the voice network and then advising the BTS that the hybrid mobile is presently available (Gilchrist does disclose receiving a non-data/GPRS page while engaged in a data/GPRS call, C4, L22-28 – hence the phone would either bar, forward or accept the call/page).

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As per **claims 12-14**, Gilchrist in view of Hays teaches claim 8 **but is silent on** wherein the response includes advising the BTS that the hybrid mobile is not present OR present but not available OR present and available.

Gilchrist teaches informing the network/caller to bar, forward and/or user is busy (C4, L9-16). One skilled would also include that the hybrid is not present OR present but not available OR present and available (eg. either the call goes to voicemail and/or a special message stating the user is not in the service provider's coverage area, eg. has traveled internationally, etc. AND/OR the call goes through if present and available).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gilchrist in view of Hays, such that the response includes advising the BTS that the hybrid mobile is not present OR present but not available OR present and available, to provide means for sending feedback to the network/caller that the user is not present/unavailable/available and/or for providing means for the hybrid user to configure multiple responses based upon their current location/usage/etc

Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Gilchrist and Hays and further in view of Shtivelman 6,078,581 (hereafter Shtivelman).

As per **claim 11**, Gilchrist in view of Hays teaches claim 8 **but is silent on** wherein the response includes forwarding the call to an Internet call waiting server.

Shtivelman teaches Internet call waiting (title) and use of a cellular phone in the application of call waiting. In alternative embodiments, additional functionality may be built in to the client's application, such as an ability to handle more than one call at a time, presenting the client with separate icons or other indicia for each call, including caller ID. The client may select to return pre-recorded messages as well, such as "Thank you for the call. I'm on an Internet session. Please call back after 4:00 PM." In another alternative the client may select to take the call as a PSTN call, and end the Internet session, at which time the system forwards the call to the client as a PSTN call to telephone 111. In yet another embodiment of the invention the client may elect to continue the Internet session, but to have the incoming call forwarded to a conventional (not Internet protocol) telephone number, such as a cellular telephone which the client

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may have nearby, or another telephone set in the same premises. In this embodiment the system is adapted to redirect the incoming call according to the recipient's selection. In this embodiment the client may set his/her routing rules in subscribing to the service to have incoming calls during browsing sessions redirected to a cell phone number, an alternate telephone at or near his/her premises, or to some other destination.

Alternatively the client may select a forwarding after being alerted to an incoming call (C5, L57 to C6, L13).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gilchrist in view of Hays, such that the call is forwarded to an ICWS server, to provide means for transferring/forwarding a call when the user is already engaged in a call and does not want to take the new call.

Allowable Subject Matter

Claims 1, 3, 5-7 and 21-23.

These claims recite highly specific limitations not found, alone or in combination, in the prior art of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEVE M. D'AGOSTA
PRIMARY EXAMINER

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1-12-06